REMARKS

The Office Action dated April 27, 2005, has been received and carefully considered. Reconsideration of the outstanding objections/rejections in the present application is also respectfully requested based on the following remarks.

I. THE OBJECTION TO THE SPECIFICATION

On page 2 of the Office Action, the specification was objected to. In particular, the attempt to incorporate subject matter into the application by reference to "CHASE TRADE WINDOWS USER GUIDE," publication CTWUG.980220, 1998 on page 5, lines 10-12 is alleged to be improper because a reference to a non-patent publication as this one which cannot be readily available to the public does not minimize the public's burden to search for and obtain copies of documents incorporated by reference. This objection is hereby respectfully traversed.

M.P.E.P 21608.01(p) clearly states that non-essential material may be incorporated by reference to non-patent publications, except for hyperlinks and/or other forms of browser executable code. Applicant respectfully submits that the "CHASE TRADE WINDOWS USER GUIDE" (CTWUG.980220) 1998, publication is properly incorporated into the application. In particular, the specification provides the name of the publication, the date of publication, and the publication reference number. Applicant respectfully submits that by providing such identification information, Applicant has properly ensured that the public may readily obtain a copy of the reference with minimal effort or burden.

In view of the foregoing, it is respectfully requested that the aforementioned objection to the specification be withdrawn.

II. THE OBJECTION TO THE DRAWINGS

On page 3 of the Office Action, Figures 1-3 are alleged to only show that which is old. This objection is hereby respectfully traversed.

Applicant respectfully submits that Figures 1 and 3 illustrate systems and methods that comprise or perform the various features and functionality of the claimed systems and methods, and not merely systems and methods that are found in the prior art. Moreover, Applicant respectfully submits that even if Figure 1 were to depict an "old" system – which it does not – such a system may nonetheless comprise an improvement of the "old" system and thus not comprise prior art. Similarly, Applicant respectfully submits that the methods disclosed in Figures 2 and 3 are not found in the prior art, but rather comprise functionality that is novel, nonobvious, and the subject matter of the pending claims. As a result, Applicant does not see the need to submit replacement drawings labeled "Prior Art."

In view of the foregoing, Applicant respectfully submits that the aforementioned objection to the drawings be withdrawn.

III. THE PATENTABILITY REJECTION OF CLAIMS 6-13

One page 4 of the Office Action, claims 6-13 were rejected under 35 U.S.C. § 101 as allegedly lacking technology.

Applicant has amended claim 6 to recite the performance of the claimed steps over a processor-based network. Claims 7-13 depend from claim 6 and thus also recite the limitation.

In view of the foregoing, it is respectfully requested that the aforementioned patentability rejection of claims 6-13 be withdrawn.

IV. THE ANTICIPATION REJECTION OF CLAIMS 1-13

On page 6 of the Office Action, claims 1-13 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by prior use or sale. This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. *In re Sun*, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. *Id.* "In addition, the prior art reference must be enabling." *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention." *Id.*

The Examiner asserts that an issue of public use has been raised in this application. While Applicant asserts that none of the claimed features and functionality is found in earlier publications or systems, Applicant nonetheless provides, as requested, a copy of the 1995 "CHASE TRADE WINDOWS USER GUIDE," (the "1995 Guide"), which was in use more than one year before the filing date of the application. Applicant submits that the 1995 Guide does not teach or suggest any feature or functionality of the claimed systems and methods.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of claims 1-13 be withdrawn.

V. THE OBVIOUSNESS REJECTION OF CLAIMS 1-13

On page 7 of the Office Action, claims 1-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Potter et al. (U.S. Patent No. 5,787,402), in view of Rosen (U.S. Patent No. 5,774,553), furthering view of Clark (U.S. Patent No. 6,058,378), and further in view of Sherree DeCovny ("Net Scope," Banking Technology, London, May, 1996, Vol. 14, Issue 4, page 28). This rejection is hereby respectfully traversed.

As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

At the outset, Applicant respectfully submits that Potter – the primary reference cited in the office action – is wholly distinguishable from the claimed systems and methods. In fact, unlike the pending claims, Potter relates to a system that customers can access on-line and in real time through various terminals such as, for example, a personal computer (PC). By inputting information in response to prompts on a screen, the system quickly identifies the nature of the

transaction the customer desires and the customer inputs the characteristics of the transaction the user desires. The system then automatically generates an offer in response to the customer's request based upon a number of parameters including the market price, the size and nature of the transaction and the size and nature of the client. The system then promptly displays the bank's offer to the customer in a clear and concise manner. The customer is then given an opportunity to accept the offer, ask that the offer be updated or reject the offer. If the customer delays for too long a period of time in deciding to accept or reject the offer, the system automatically withdraws and updates the offer thereby protecting the bank from liability for a "stale" rate. If accepted, the trade is automatically forwarded for processing and assigned a reference number for tracking and control purposes. *See* Potter, Abstract.

Regarding independent claims 1 and 6, the Examiner asserts that Potter teaches "a system and method for processing funds transfer transactions from a customer of a financial institution." The Examiner also asserts that Potter teaches "a second processor coupled to the first processor, the second processor receiving the same currency funds transfer transactions not requiring a foreign exchange operation from the first processor." Further, the Examiner asserts that "the second processor generat[es] first fund transfer instructions in response to the same currency funds transfer transactions." As support for these assertions, the Examiner cites to following excerpt from Potter:

> Money Market Trade Execution Server (Money Market Server) (106)
>
> This server allows a client to deposit a foreign currency for a short-term deposit at a specified deposit rate. ***The financial institution uses the FX Trade Server to swap the deposit for USD for the deposit's duration***. At the end of that duration, if a client has not opted for a rollover at least two business days before the maturity date of the deposit, USD are ***swapped back*** to the original foreign

> currency, both principal and interest accrued at the specified deposit rate, with principal and interest returned to the client in the original currency.

See Potter, Col. 5, lines 3-14 (emphasis added).

However, as evidenced by the emphasized portion of the excerpt, the Money Market Server 106 does indeed "swap" currency during a deposit. Applicant respectfully submits that by "swapping" currency Money Market Server 106 is in fact conducting or requiring a foreign exchange operation. Accordingly, Applicant respectfully submits that Potter does not teach or suggest "a second processor coupled to the first processor, the second processor receiving the same currency funds transfer transactions not requiring a foreign exchange operation from the first processor," as expressly recited in independent claims 1.

Further, Applicant respectfully submits that the above excerpt does not teach or suggest any feature or functionality that even remotely discloses "the second processor generating first fund transfer instructions in response to the same currency funds transfer transactions." For one, there is no mention in the excerpt of any feature or functionality that could comprise a fund transfer instruction, or a fund transfer instruction that is generated in response to a same currency funds transfer transaction. Rather, the excerpt merely states that "both principal and interest accrued at the specified deposit rate, with principal and interest returned to the client in the original currency." Applicant is perplexed at how such a disclosure may be found to teach or suggest "the second processor generating first fund transfer instructions in response to the same currency funds transfer transactions," as expressly required by independent claim 1.

The Examiner asserts that Potter teaches "a funds transfer processor coupled to the second processor, the funds transfer processor receiving the first funds transfer instructions from

the second processor and executing the received first funds transfer instructions by transferring funds to a funds transfer processor of another financial institution." As support for this assertion the Examiner cites to the following excerpt of Potter:

> Upon receipt and validation of Payment Order messages, the FX Trade Server executes the currency transactions (refer to FIG. 7).
>
> The Payment Order Server receives incoming payment messages by the SWIFT Agent Server 122 or the Batch File Server 116 via direct internal financial institution user log-in to the Payment Order Server (refer to FIG. 29). FIG. 13 illustrates the different components and methods of messages being received by the Payment Order Server, processed, and submitted to the FX Trade Server, as is described below. The SWIFT Agent Server receives messages predicated on worldwide SWIFT standards and protocols, as commonly known in the FX and banking industry. Customers may send SWIFT messages directly to the SWIFT Agent Server. FIG. 28 represents a message to the Payment Order Server in the original SWIFT format. FIG. 27 represents an original SWIFT message broken down into its constituents, or parsed, for easier reading. The Payment Order Server acknowledges receiving the SWIFT messages; in turn, the SWIFT Agent Server deletes the acknowledged files from its memory.
>
> Banks can employ either the SWIFT network to transmit messages in SWIFT-sanctioned format (MT100) or a batch file transfer method to send payment messages from the individual financial institution. If from the latter, the Batch File Server determines which of the messages contained in the financial institution's mainframe are for foreign currency exchange by the Payment Order server, retrieves those messages and passes these messages to the Payment Order Server. The Payment Order Server acknowledges receiving the Batch Files; in turn, the Batch File Server deletes the acknowledged files from its memory.
>
> Customers can log-in to the Payment Order Server, using the log-in process that FIGS. 3-4 depict. However, user profile validation is performed by the FX Trade Server at the time the Payment Order Server sends Payment messages to the FX Trade Server prior to trade execution (refer to FIG. 7).
>
> Customers can review Payment Order inbound messages on a blotter (see FIG. 26). The blotter's information includes--the Date (of payment message submittal), the Sender identification, the payment Receiver, payment Status, Buy currency (the foreign currency), Sell currency (USD), the transaction amount, and the Payment Order transaction number.

See Potter, Col. 15, lines 16-60.

Applicant respectfully submits that the above excerpt does not teach or suggest "a funds transfer processor coupled to the second processor, the funds transfer processor receiving the first funds transfer instructions from the second processor and executing the received first funds transfer instructions by transferring funds to a funds transfer processor of another financial institution." As set forth above, the Examiner cites to the Money Market Server 106 as disclosing the claimed "second processor." However, the above excerpt does not teach or suggest the Payment Order Server – which the Examiner appears to comprise the claimed "funds transfer processor – as receiving any data or information from the Money Market Server 106. Rather, Payment Order Server receives incoming payment messages from the SWIFT Agent Server 122 or the Batch File Server 116, not Money Market Server 106. Accordingly, Applicant respectfully submits that Potter does not teach or suggest a funds transfer processor coupled to the second processor, the funds transfer processor receiving the first funds transfer instructions from the second processor and executing the received first funds transfer instructions by transferring funds to a funds transfer processor of another financial institution," as expressly required by claim 1.

The Examiner concedes that Potter does not disclose "grouping the plurality of funds transfer transactions," but ignores the remainder of the claim language stating that the plurality of funds transfer transactions are grouped "into funds transfer transactions requiring a foreign exchange operation, denoted as foreign exchange funds transfer transactions, and funds transfer transactions not requiring a foreign exchange operation, denoted as same currency funds transfer

transactions." However, the Examiner asserts that Rosen makes up Potter's deficiency in this regard and references the following excerpt from Rosen as support:

> Foreign exchange trading can be settled in one of three ways:
>
> 1) gross settlement--payments are accumulated on a trade-by-trade basis;
>
> 2) bilateral net settlement--payments are based on netting the trades for two counterparties; and
>
> 3) multilateral net settlement--payments are based on netting the trades for more than two counterparties as a group.

See Potter, Col. 26, lines 14-27.

However, Applicant respectfully submits that the cited excerpt does not teach or suggest any feature or functionality comprising "grouping the plurality of funds transfer transactions into funds transfer transactions requiring a foreign exchange operation, denoted as foreign exchange funds transfer transactions, and funds transfer transactions not requiring a foreign exchange operation, denoted as same currency funds transfer transactions," as expressly recited in claims 1 and 6.

Further, Applicant respectfully submits that the Examiner has not set forth any motivation as to why someone of ordinary skill in the art would combine the teachings of Potter with Rosen. Rather, on page 13 of the office action the Examiner merely states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Potter et al. method and system to use ... "the first processor grouping the plurality of funds transfer transactions" as taught by Rosen...." Applicant respectfully submits that in not

providing or specifying what would motivate to one to make the modification or combination, the Examiner has failed to set forth a prima facie case of obviousness.[1]

Applicant respectfully submits that none of the other cited references – namely Clark and DeCovny – make up Potter and Rosen's deficiencies. Accordingly, Applicant respectfully submits that independent claims 1 and 6 are valid over the cited references.

Claims 2-5 and 7-13 are dependent upon independent claim 1 or 6. Thus, since independent claim 1 and 6 should be allowable as discussed above, claims 2-5 and 7-13 should also be allowable at least by virtue of their dependency on independent claim 1 or 6. Moreover, these claims recite additional features which are not claimed, disclosed, or even suggested by the cited references taken either alone or in combination. For example, claim 5 recites "a market link from the trading processor to a foreign exchange market, wherein the trading processor receives real time foreign exchange rates over the link. Applicant respectfully submits that none of the cited references teach or suggest such a feature or functionality as part of the system of claim 1.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 1-13 be withdrawn.

VI. CONCLUSION

[1] As stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

Hunton & Williams LLP

By: _____
Ozzie A. Farres
Registration No. 43,606

Hunton & Williams LLP
1900 K Street, N.W.
Washington, D.C. 20006-1109
Telephone: (202) 955-1500
Facsimile: (202) 778-2201

Date: August 29, 2005